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10/722,313	11/25/2003	Henry Hsu	OSSUR.039A	9305

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EXAMINER

KOSLOW, CAROL M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/722,313

Applicant(s)

HSU ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14-17 and 20-77 is/are pending in the application.
- 4a) Of the above claim(s) 20-37 and 77 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 14-17, 39-46 and 62-76 is/are allowed.
- 6) ☒ Claim(s) 47-56 and 58-60 is/are rejected.
- 7) ☒ Claim(s) 57 and 61 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/29/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This action is in response to applicants' amendment of 29 April 2005. The amendments to the specification have overcome the previous objection to the drawings and the objection to the specification with respect to the lack of antecedent basis for the combinations of claims 12 and 32. The amendments to the specification have overcome the objections to the claims and the 35 USC 112 rejection. Applicants' arguments with respect to the support in the specification for the combinations of claims 8, 9, 28 and 29 have been considered and are persuasive. It is noted that paragraph [0026] teaches the combination of carrier fluids, not paragraph [0028] as argued. Applicant's arguments with respect to the art rejections have been fully considered but they are not persuasive.

The German language WO patents cited in the information disclosure statement of 29 April 2005 have been considered with respect to the provided English abstracts.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the figures: Figures 1 and 2 do not mention reference numbers 256, 258, 264, 266, 268, 270, 276 and 284, discussed in paragraphs [0040H], [0040M]-[0040O]. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The amendment filed 29 April 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Paragraphs [0040A]-[0040Z].

Applicant is required to cancel the new matter in the reply to this Office Action.

The amendment was not accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application, as required. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Newly submitted claims 20-37 and 77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

These claims are directed to a prosthetic knee system which is different than the originally filed magnetorheological fluid. The originally filed prosthetic knee and the originally filed fluid related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the fluid in the knee

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does not need to have the claimed of the fluids of claims 1-9, 14-17, 39-46 and 62-76. The subcombination has separate utility such as the fluid in engine mounts.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-37 and 77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

This application contains claims 20-37 and 77 drawn to a nonelected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 47-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/10281.

U.S. patent 6,780,343 is the translation of WO 02/10281.

This reference teaches a magnetorheological fluid comprising iron particles (col. 2, lines 45-47), a carrier fluid, such as silicones, hydrocarbons, mineral oil, ethers, esters and mixtures thereof (col. 3, lines 6-25), and as a dispersant, perfluoroether carboxylic acid salts (col. 3, lines 40-44). The fluid is used in dampers, shock absorbers, elevators and other devices which function over the range of 10-115°F, therefore the taught fluid is operable over the claimed temperature range. The taught iron powders have a particle size in the range of 0.1-100 microns (col. 2, lines 60-61), which overlaps the claimed ranges. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re*

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*Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The amount of iron particles is 10-90 wt%, which when converted to volume percent, would be expected to overlap the claimed ranges (col. 5, lines 9-11). The reference suggests and makes obvious the claimed fluid.

Claims 55 and 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/10281 as applied to claims 1, 8, 20 and 28 above, and further in view of U.S. patent 5,382,373.

As discussed above, WO 02/10281 suggests the claimed fluid. It does not teach the carrier can be a perfluorinated polyether or the amount of perfluoroether carboxylic acid salt dispersant. Column 3, lines 6-9 teaches the carrier fluid can be any low vapor pressure oil commonly known to be used for magnetorheological fluids. Column 4, lines 34-45 of U.S. patent 5,382,373 teach conventional carrier fluids for magnetorheological fluids. This section teaches those taught in WO 02/10281 and also includes perfluorinated polyethers. This would suggested to one of ordinary skill in the art that perfluorinated polyesters are functionally equivalent to those in WO 02/10281 and one of ordinary skill in the art would have found it obvious to use a perfluorinated polyether as the carrier fluids for the magnetorheological fluid of WO 02/10281. U.S. patent 5,382,373 teaches the amount of dispersant added in magnetorheological fluids is 0.1-20 wt%, based on the weight of the particles (col. 6, lines 1-3), which when calculated as volume percentage based on the amount of dispersant and carrier, would appear to overlap the claimed range. One of ordinary skill in the art would have found it obvious to use this known

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amount of dispersant for the taught perfluoroether carboxylic acid salt dispersant in WO 02/10281. The references suggest the claimed fluid.

The presence of the taught polyether dispersing agent does not overcome the rejection since it can have a molecular weight in the solid range. Thus it would not be part of the fluid component and thus not be excluded by the phrase "consisting essentially of". When the polyether dispersing agent is present as a liquid it would also not be excluded by the phrase "consisting essentially of" because it would not materially affect the basic and novel characteristic(s) of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). There is nothing in the specification indicating to one of ordinary skill in the art that other dispersing agents, known to be used in magnetorheological fluids, cannot be added to the claimed fluid and that such an addition would impair the function of the fluid. Applicants argue one of ordinary skill in the art would not combine the teachings of the two patents used in the rejections because of the focus U.S. patent 5,382,373 is on the composition of the magnetic particle used in the taught magnetorheological fluid. This does not explain why one of ordinary skill in the art would not use the other teachings in the reference with respect to the other taught aspects of magnetorheological fluids. The two patents are in the same field of endeavor. The rejections are maintained.

Claims 1-9, 14-17, 39-46 and 62-76 are allowable over the cited art of record.

Claims 57 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

These claims are allowable for the reasons given in the previous action.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk  
June 26, 2005

  
C. Melissa Koslow  
Primary Examiner  
Tech. Center 1700